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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,404	01/28/2004	Frederick J. Dojan	005127.00280	2856

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PLUMSEA LAW GROUP, LLC
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EXAMINER

MIGGINS, MICHAEL C

ART UNIT	PAPER NUMBER
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1772

MAIL DATE	DELIVERY MODE
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06/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/767,404	DOJAN ET AL.	
	Examiner	Art Unit	
	Michael C. Miggins	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 41-46 is/are pending in the application.
- 4a) Of the above claim(s) 18-25 and 41-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/13/04, 4/29/05, 1/4/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 1-17 in the reply filed on 11/8/06 is acknowledged. The traversal is on the ground(s) that the election of species is improper because claims 1-25 and 41-46 correspond to a single species depicted in Figures 1-11 since claims themselves are never species. However, in accordance with MPEP 806.04(f) each species of claims 1-17, 18-25 and 41-46 are mutually exclusive since each species recite limitations which are not exclusive to that species and are not recited in any other species as illustrated in the election/restriction requirement of 10/12/06.
2. This application contains claims 18-25 and 41-46 drawn to an invention nonelected with traverse in Paper No. 11/8/06. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

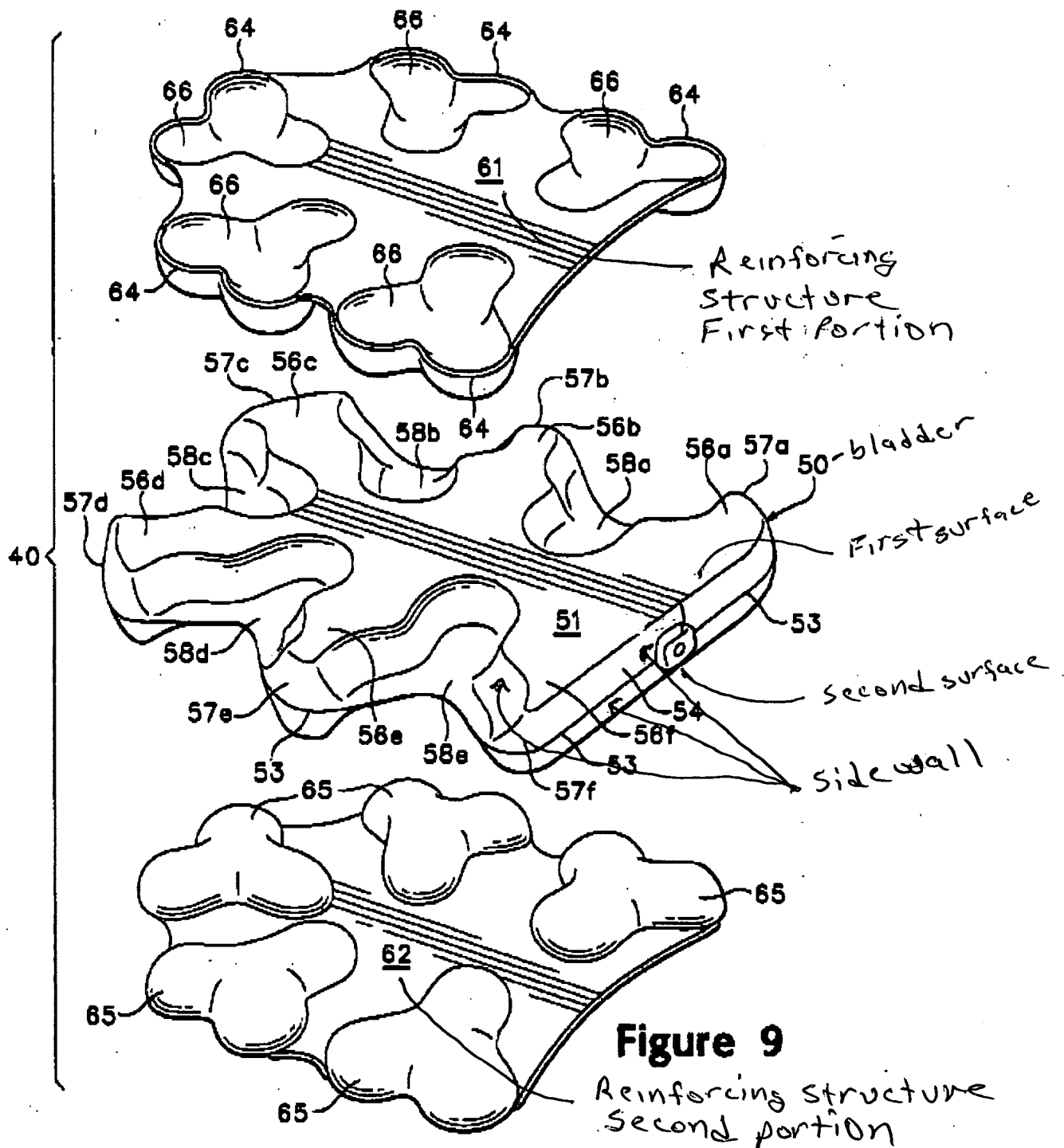
A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 4-7 and 9-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Swigart et al. (US 2005/0028403).

Swigart discloses a component comprising a bladder formed of a barrier material (since chamber 50 contains air, page 4, paragraph [0044]), the bladder enclosing a fluid that exerts an outward force upon the barrier material (since chamber 50 contains air, page 4, paragraph [0044]), and a reinforcing structure at least partially recessed into the barrier material and bonded to the barrier material (page 4, paragraph [0048]), at least a portion of the reinforcing structure being placed in tension by the outward force upon the barrier material (since a pressure greater than 5 psi may be placed in the bladder, page 4, paragraph [0044]) and wherein the reinforcing structure is formed of a semi-rigid material that is bonded to the bladder (page 4, paragraph [0048], page 5, paragraph [0053]) (see also Figs. 9 and 5 along with annotations below).

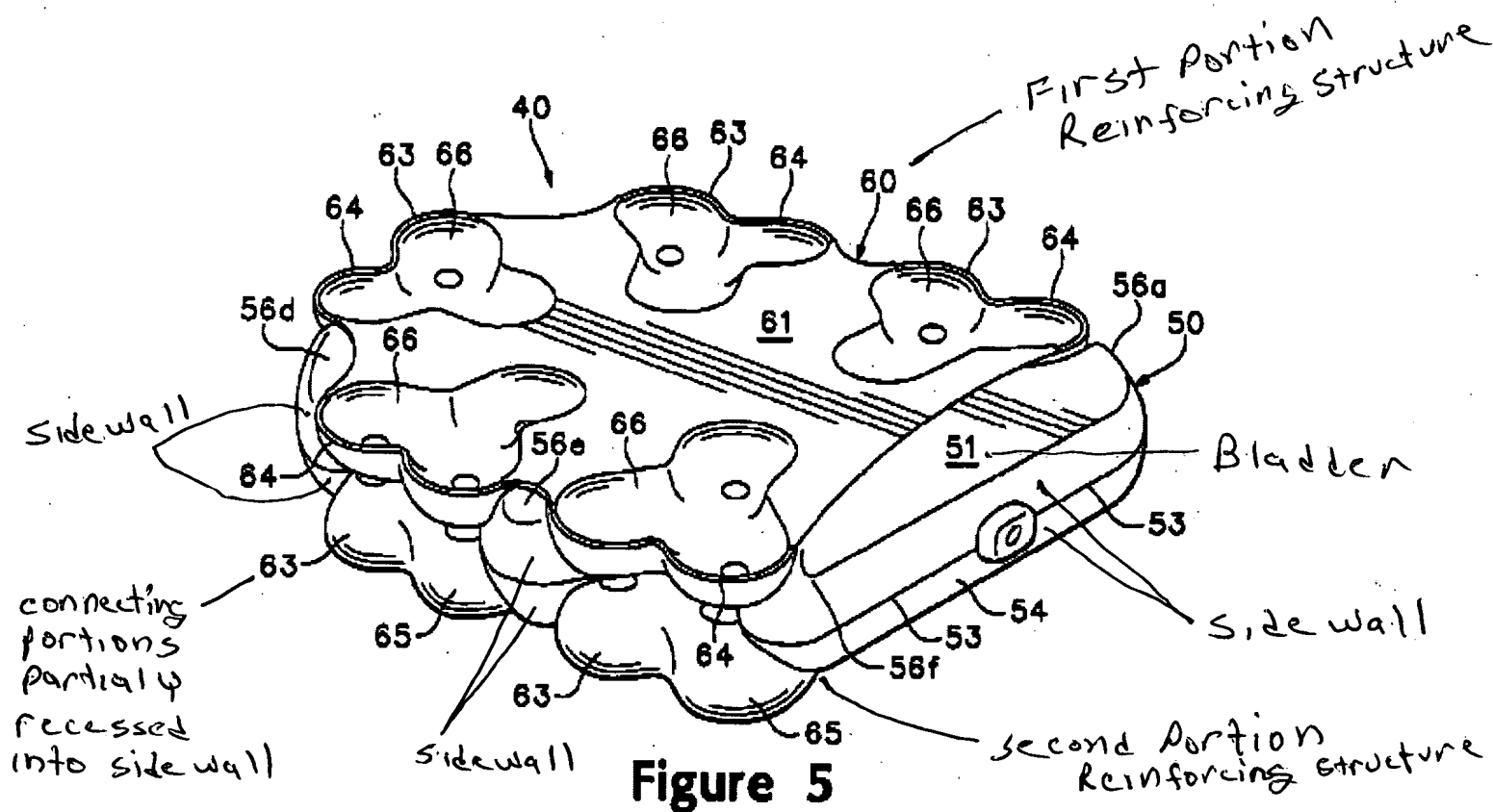
Swigart also discloses wherein the bladder includes a first surface, an opposite second surface and a sidewall extending between the first surface and the second surface (see Fig. 9 below).



Swigart discloses wherein the reinforcing structure has a first portion, a second portion and a plurality of connecting portions (63) extending between the first portion

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and the second portion and wherein the first portion is secured to the bladder at an interface between the first surface and the sidewall, and the second portion is secured to the bladder at an interface between the second surface (page 4, paragraph [0048], page 5, paragraph [0051]) and the sidewall and wherein the connecting portions are at least partially recessed into the sidewall (see Figs. 4, 6 and 5 below).



Swigart discloses wherein a material forming the reinforcing structure has a greater modulus of elasticity than a material forming the bladder (since the material of the reinforcing element is formed of an elastomer and the bladder is formed of a thermoplastic material, page 4, paragraph [0044], page 5, paragraph [0053]), wherein the reinforcing structure is formed of at least two different materials (page 5, paragraph

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[0053]) and wherein the pressurized fluid exerts an outward force upon the barrier material and at least a portion of the reinforcing structure, wherein the reinforcing structure restrains distension of the barrier material, or a sidewall of barrier material, due to the outward force upon the barrier material (since a pressure greater than 5 psi may be placed in the bladder, page 4, paragraph [0044]).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swigart et al. (US 2005/0028403) in view of Passke et al. (US 2005/0132606).

Swigart fails to disclose wherein a plurality of interior bonds join the first surface with the second surface, the interior bonds being spaced inward from the sidewall and wherein the interior bonds restrain distension of the first surface and the second surface due to the outward force upon the barrier layer.

Passke discloses wherein a plurality of interior bonds join the first surface with the second surface, the interior bonds being spaced inward from the sidewall and wherein the interior bonds restrain distension of the first surface and the second surface due to the outward force upon the barrier layer (page 5, paragraph [0050] and Fig. 5C) in a bladder for foot wear (page 1, paragraph [0010]) for the purpose of preventing the

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ingress of particles and liquids (page 1, paragraph [0009]) as well as improving comfort for the consumer.

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided wherein a plurality of interior bonds join the first surface with the second surface, the interior bonds being spaced inward from the sidewall and wherein the interior bonds restrain distension of the first surface and the second surface due to the outward force upon the barrier layer in the bladder to Swiggart in order to prevent the ingress of particles and liquids as well as improving comfort for the consumer as taught or suggest by Passke.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swigart et al. (US 2005/0028403) in view of Pavone (US 6192606).

Swigart fails to disclose wherein the bladder includes a first chamber and a separate second chamber with different pressures.

Pavone discloses wherein the bladder includes a first chamber and a separate second chamber with different pressures (column 3, lines 25-45 and Figs. 1-3) for the purpose of providing additional lift and power to the wearer.

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided wherein the bladder includes a first chamber and a separate second chamber with different pressures in the invention of Swigart in order to provide additional lift and power to the wearer as taught or suggested by Pavone.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application Nos. 10/767,403, 10/767,211, 10/767,212 and 10/767,465. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are simply broader (simply not reciting a shoe and the bladder contained within the sole of the shoe) than those recited in the copending applications and it would be obvious to simply exclude other elements.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

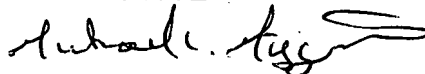
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is 571-272-1494. The examiner can normally be reached on 1:00-10:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael C. Miggins
Primary Examiner
Art Unit 1772



MCM
February 5, 2007